REMARKS

This is a full and timely response to the non-final Official Action mailed **January 27, 2006.** Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

By the forgoing amendment, various claims have been amended. No new claims are added.

Claims 37-60 and 67 were withdrawn under a previous Restriction Requirement and are cancelled herein. The withdrawn claims are cancelled without prejudice or disclaimer. Applicant reserves the right to file any number of continuation or divisional applications to the withdrawn claims or to any other subject matter described in the present application.

Thus, claims 1-36 and 61-66 are currently pending for further action.

Claim Objection:

The recent Office Action objected to claim 15 for containing the term "ZIP." Accordingly, claim 15 has been amended to clarify the intended subject matter. This amendment does not, and is not intended to, narrow or change the scope of claim 15. Following entry of this amendment, the objection to claim 15 should be reconsidered and withdrawn.

35 U.S.C. § 112, Second Paragraph:

The recent Office Action also rejected claims 21 and 35 under 35 U.S.C. § 112, second paragraph, because the term "content" was held to lack sufficient antecedent basis.

Accordingly, Applicant has amended claims 21 and 35 herein to provide the requisite antecedent basis. These amendments do not, and are not intended to, narrow or change the scope of claim 21 or 35. Following entry of this amendment, claims 21 and 35 are believed to be in compliance with 35 U.S.C. § 112, and notice to that effect is respectfully requested.

Prior Art:

Claims 1-12, 14, 15, 19-36, 61-63, 65 an d 66 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 6,633,888 to Kobayashi ("Kobayashi") and U.S. Patent No. 5,611,066 to Keele ("Keele"). This rejection is respectfully traversed for at least the following reasons.

Claim 1 recites:

> A method of creating an archived file in a manner that allows an application to distinguish between one or more data files and one or more print files in said archived file comprising
> generating a manifest file; and
> including said manifest file in said archived file;
> wherein said manifest file indicates to said application a file location within said archived file associated with said one or more data files and a file location associated with said one or more print files.

Independent claim 61 recites:

> A system for creating an archived file in a manner that allows an application to automatically distinguish between one or more data files and one or more print files in said archived file, said system comprising:
> means for generating a manifest file, said manifest file indicating to said application a file location associated with said one or more data files and with said one or more print files; and
> means for including said manifest file in said archived file.

Independent claim 66 recites:

> A processor readable medium having instructions thereon for:
> generating an archived file;
> generating a manifest file; and
> including said manifest file in said archived file;

> wherein said manifest file indicates to an application a file location within said archived file associated with one or more data files and a file location associated with one or more print files.

Applicant's specification defines the term "print file" as follows: "'print file' will be used to refer to any file that is used by an application to print content associated with an optical disc." (Applicant's specification, paragraph 0018).

In contrast, the combination of Kobayashi and Keele fails to teach or suggest the claimed method in which a manifest file is included in an archived file and identifies a file location within the archived file of print files as opposed to data files. In this regard, the recent Office Action alleges that Kobayashi teaches generating the claimed manifest file and including the manifest file in an archived file. (Action of 1/27/06, p. 3). In support of this argument, the Action cites Kobayashi at col. 7, lines 49-51. This portion of Kobayashi reads as follows:

> Because Java programs are intended to be transmitted over the Internet, the final program is packaged into what is referred to as a Java Archive (JAR) file. The JAR file is actually a "zipped", or compressed, file which includes all related files for that application, applet, or component. Also included in the JAR file is a manifest file, which includes extra information concerning the zipped portion of the file. For example, the manifest file can indicate the contents of the JAR file and whether a particular zipped file is a bean or a resource file, its file version number, and so on.

(Kobayashi, col. 7, lines 46-55).

Thus, the manifest file taught by Kobayashi has nothing to do with identifying a location of print files as opposed to data files in an archived file as in Applicant's claimed method. Rather, Kobayashi teaches a method of delivering Java programs. Kobayashi has nothing to do with the claimed method of creating an archive file including print and data files with a manifest file that distinguishes the location, and thus the type, of the print and data files.

The teachings of Keele do not in any way remedy these shortcomings of Kobayashi. Keele teaches that printed material associated with a compact disc (CD) is generated using data written on the CD itself. According to Keele, "CD-W labels, packing slips, etc. are printed, normally off-line, for each CD-W from the unique data stored within the CD-W itself." (Keele, abstract). Thus, Keele does not teach or suggest an archived file that includes separate data and print files, or a manifest file that locates each.

Consequently, the combined teachings of Kobayashi and Keele fail to teach or suggest all the features of claim 1, particularly, a manifest file that "indicates to [an] application a file location within said archived file associated with said one or more data files and a file location associated with said one or more print files." "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, for at least these reasons, the rejection of claims 1, 61, 66 and their respective dependent claims based on Kobayashi and Keele should be reconsidered and withdrawn.

Independent claim 23 recites:

> A method of creating an archived file in a manner that allows an application to distinguish between one or more data files and one or more print files in said archived file comprising:
>
> using an enforced directory structure in said archived file;
>
> wherein said enforced directory structure indicates to said application a file location associated with said one or more data files and a file location associated with said one or more print files.

In contrast, as demonstrated above, neither Kobayashi nor Keele teach or suggest an archived file that includes both data and print files. Kobayashi teaches a JAR file containing Java programs, and does not teach or suggest an archived file including print files. Similarly,

Keele does not appear to teach or suggest an archived file including print files as defined and claimed by the Applicant. Consequently, the combination of Kobayashi and Keele cannot teach or suggest such an archived file with an enforced directory structure that separates and identifies the location of print files as opposed to data files.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, for at least these reasons, the rejection of claim 23 and its dependent claims based on Kobayashi and Keele should be reconsidered and withdrawn.

Additionally, the various dependent claims of the application recite subject matter that is clearly patentable over the prior art of record. Specific examples follow.

Claim 2 recites:

> The method of claim 1, further comprising:
> extracting files from said archived file with said application, said files including said one or more data files, said one or more print files, and said manifest file;
> burning said one or more data files onto an optical disc; and
> printing content corresponding to said one or more print files.

Claims 24 and 62 recites similar subject matter.

In contrast, as demonstrated above, Kobayashi does not teach or suggest anything about print files in an archived file and thus cannot teach or suggest extracting data and print files from an archived file. Keele also does not teach or suggest extracting print files from an archived file and then printing content corresponding to those files. Rather, as demonstrated above, Keele teaches extracting data written to a CD to generate printed labeling, etc. for the

disc. (Keele, col. 28, line 64-67). Consequently, the combination of Kobayashi and Keele fails to teach or suggest all the features of claim 2, 23 or 62. For at least this additional reason, the rejection of claims 2, 23, 62 and their respective dependent claims should be reconsidered and withdrawn.

Claim 20 recites:

> The method of claim 1, further comprising:
> including said manifest file in any directory of said archived file; and
> including a boot file in a root directory of said archived file, said boot file indicating a path of said manifest file in said archived file;
> wherein said application is configured to recognize and read said boot file.

In contrast, the combination of Kobayashi and Keele fails to teach or suggest this subject matter. In this regard, the Office Action cites Keele at col. 41, lines 19-21. (Action of 1/27/06, p. 8). However, this portion of Keele discusses a boot record that is potentially used to boot a computer from a CD. According to Keele, "[a] Boot Record consists of potentially several optional fields permitting the user to specify information about the boot record. However, CD-W standards do not currently support booting off the CD, so this feature is reserved for future use." (Keele, col. 41, lines 19-21).

Consequently, the boot record taught by Keele has nothing to do with the boot file claimed by Applicant. Most importantly, the boot record taught by Keele is not part of an archived file and does not indicate the location of a manifest file that is also in the archived file as claimed. For at least this additional reason, the rejection of claim 20 should be reconsidered and withdrawn.

Claims 13, 16-18 and 64 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Kobayashi, Keele and U.S. Patent Application Publication No. 20040019596 by

Taylor ("Taylor"). This rejection is respectfully traversed for at least the same reasons given above with respect to the independent claims of the application.

Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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